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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,969	12/01/2003	Jordi Albornoz	POU920030183US1	3005
46429 7590 06/04/2009 CANTOR COLBURN LLP-IBM POUGHKEEPSIE 20 Church Street 22nd Floor Hartford, CT 06103				
EXAMINER				
WALSH, JOEIN B				
ART UNIT		PAPER NUMBER		
2451				
NOTIFICATION DATE		DELIVERY MODE		
06/04/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

### Office Action Summary

**Application No.**

10/724,969

**Applicant(s)**

ALBORNOZ ET AL.

**Examiner**

John B. Walsh

**Art Unit**

2451

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13, 14, 16 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13, 14, 16 and 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 13, 14, 16, 21 - 24 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication 2001/0037453 to Mitty et al.

As concerns claim 13, a method for instant messaging in a network communication system comprising: formulating at the sending computing device (0012) a combined message to a recipient (0011), said combined message including a predictive code (0012) and a communications message (0012); establishing a state variable associated with said recipient (0032;0086), the state variable including one or more parameters (0032;0086; 0059), wherein said state variable includes a function (0033; 0086) configured to select code operating at the recipient computing device and the state variable is updated by the selected code (0086; 0094;0120), the state variable being stored at the recipient computing device (0120-stored data;0126); and transmitting said code and said communications message to the recipient computing device (0012); executing the predictive code at the recipient computing system (0034;0056); and delivering the communications message to the recipient computing system if the predictive code returns a first value (0034-validated) and discarding the communications

message if the predictive code returns a second value (0081-if not validated must be retransmitted thus initial message is discarded).

As concerns claim 14, transmitting a modifying code to the recipient that causes the persistent state associated with the recipient to be modified (0086;0094).

As concerns claim 16, wherein said state variable corresponds to one or more aspects of a state of said recipient (0086).

As concerns claim 21, further including storing a state variable on a server separate from a recipient (0048- intermediary 115;0053).

As concerns claim 22, wherein said code evaluates a state of said recipient (0086).

As concerns claim 23, wherein said state of said recipient includes whether a message has been previously received (0086; 0049).

As concerns claim 24, further including establishing a security mechanism at a recipient to ensure that code transmitted to, and executed at, a recipient is noninvasive (0022;0050;0056).

3. Claims 13, 14, 16, 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,282,709 to Reha et al.

As concerns claim 13, a method for instant messaging in a network communication system comprising: formulating at the sending computing device (server) a combined message to a recipient (system 100), said combined message including a predictive code (col. 9, lines 35-40; col. 5, lines 1-12) and a communications message (col. 9, lines 56-60; note applicant indicates at 0005-0006 code and message can be sent separately); a state variable associated with said recipient (col. 2, lines 13-17; software versions), the state variable including one or more

parameters (software version number is a parameter), said state variable includes a function (col. 4, lines 1-7; 55-62) configured to select code operating at the recipient computing device and the state variable is updated by the selected code (col. 9, lines 53-60; col. 7, lines 20-25), the state variable being stored at the recipient computing device (col. 9, lines 55-60; storage device 108); and transmitting said code and said communications message to a recipient (col. 9, lines 53-60; col. 7, lines 20-25); executing the predictive code at the recipient (col. 9, lines 53-60; col. 7, lines 20-25); and delivering the communications message to the recipient if the predictive code returns a first value and discarding the communications message if the predictive code returns a second value (col. 9, lines 35-60).

As concerns claim 14, transmitting a modifying code to the recipient that causes the persistent state associated with the recipient to be modified (col. 5, lines 60- col. 6, line 6; version).

As concerns claim 16, wherein said state variable corresponds to one or more aspects of a state of said recipient (col. 5, lines 60- col. 6, line 6; version).

As concerns claim 21, further including storing a state variable on a server separate from a recipient (col. 5, lines 8-10; server version compared to local system).

As concerns claim 22, wherein said code evaluates a state of said recipient (col. 9, lines 35-60).

As concerns claim 23, wherein said a state of said recipient includes whether a messages has been previously received (col. 9, lines 35-60; current or non-existent checked).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,282,709 to Reha et al. as applied above in view of U.S. Patent Application Publication 2001/0037453 to Mitty et al.

Reha et al. '709 do not explicitly disclose a security mechanism.

Mitty et al. '453 teach a security mechanism (0022;0050;0056).

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide the system of Reha et al. '709, with a security mechanism, as taught by Mitty et al. '453, in order to provide a means of protecting the integrity of the data on the computer system. Such a modification is a combination of known elements yielding predictable results.

***Response to Arguments***

6. Applicant's arguments filed March 20, 2009 have been fully considered but they are not persuasive.

Applicant's arguments are not persuasive since they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The applicant has indicated

particular limitations and cites a general allegation that neither Mitty not Reha teach or suggest. These references as indicated in the above rejections recite the claimed limitations.

### *Conclusion*

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Thursday from 8:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information

Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John B. Walsh/  
Primary Examiner, Art Unit 2451